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EXAMINER

LOVERING, RICHARD D

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 08/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/900,229

Applicant(s)
DAHANANAKE ET AL

Examiner
LOVERING

Group Art Unit
1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on JULY 6 + OCT. 3, 2001
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-99 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-99 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) (3 SHEETS FROM PARENT CASE)
- ☒ Notice of Reference(s) Cited, PTO-892, 1 SHEET FROM PARENT CASE, NEW HEREIN
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit 1712

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 10-20, 25, 27, 90-93 and 95-99 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kersnar et al. 4,122,043 esp. Examples 4 and 6. While Kersnar et al. may not state that their aqueous detergent compositions containing amidobetaines are viscoelastic, these compositions of Kersnar et al. would be inherently viscoelastic because they contain the same zwitterionic or amphoteric surfactants and organic or inorganic acids or their salts at the same concentrations as those recited in applicants' claims.

Art Unit 1712

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4. Claims 21-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kersnar et al. above. The especially pertinent portions of Kersnar et al. are pointed out in the preceding paragraph. While the above-stated Examples of Kersnar et al. may not use amidobetaines in which R_3 and R_4 (corresponding to applicants' R_2 and R_3) are both beta-hydroxyethyl or methyl, Kersnar et al. (column 2, line 60 - column 3, line 35) suggest the interchangeability of such amidobetaines with those of their Examples 4 and 6, thus rendering their substitution prima facie obvious.

5. Claims 7-9, 28, 30, 31-48, 53, 55-79, 84 and 86-89 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kersnar et al. above in view of Rubin et al. 4,375,421. Kersnar et al. applies as in paragraph 3 above. While the aqueous detergent compositions of Examples 4 and 6 of Kersnar et al. may not contain an anionic surfactant at 1.2% or less by weight, it would have been obvious to one skilled in the art at the time applicants' invention was made to incorporate an anionic surfactant at a concentration of 0.25% by weight into the aqueous detergent compositions of Examples 4 and 6 of Kersnar et al. to obtain an increased thickening thereof in view of the teachings of Rubin et al. (column 9, lines 10-20), noting that their aqueous compositions also contain alkyl-or alkenyl-amidobetaines.

Art Unit 1712

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6. Claims 49-52 and 80-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kersnar et al. as applied to claims 21-24 above, and further in view of Rubin et al. above. While the above-modified aqueous detergent compositions of Examples 4 and 6 of Kersnar et al. may not contain an anionic surfactant at 1.2% or less by weight, it would have been obvious to one skilled in the art at the time applicants' invention was made to incorporate an anionic surfactant at a concentration of 0.25% by weight into the above-modified aqueous detergent compositions of Examples 4 and 6 of Kersnar et al. to obtain an increased thickening thereof in view of the teachings of Rubin et al. (loc cit), noting that their aqueous compositions also contain alkyl-or alkenyl-amidobetaines.

7. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit 1712

8. Claims 1-99 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,258,859.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims read on, or at least overlap, the claims of the '859 patent.

9. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claim 29 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The expression "the zwitterionic surfactant being present at .89% or more by weight of the fluid" lacks antecedent basis and support in the specification and in the parent case of this continuation application, and is considered new matter.

11. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

Art Unit 1712

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 16, 48, 77, 82, 83 and 96 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

a) Claim 16 is indefinite and inaccurate in depending upon claim 15 (instead of claim 14);

b) claim 48 is indefinite and incomplete in lacking a period after "ethylene" in line 1;

c) claim 77 is indefinite and confusing in reciting a period after "and" in line 1;

d) claim 83 is indefinite and inaccurate in reciting "Q" instead of --O-- in the formula in line 1;

e) claims 82 and 83 are indefinite, inaccurate and confusing and improper dependent claims in reciting " R_2 and R_3 are each methyl" when claim 80 (upon which they ultimately depend) recites " R_2 and R_3 are each beta-hydroxyethyl". (Claim 83 should be rendered dependent upon claim 73.); and

f) claim 96 recites a Markush group which is not considered proper for the reasons that it is indefinite as to scope and incomplete as to its membership in reciting "among" instead of --the group consisting of--.

Art Unit 1712

13. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

14. The disclosure is objected to because of the following informalities: In the specification, page 3, line 2, "FIGURES" should be changed to --DRAWINGS--.

Appropriate correction is required.

15. Applicants should insert the status of the parent case (now U.S. Patent No. 6,258,859) on page 1 of the specification, lines 7 and 10

16. The remaining references listed on the attached Forms PTO-1449 (three sheets from the parent case) and Forms PTO-892 (one sheet from the parent case) are cumulative to the references applied herein, and/or further show the state of the art.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc
August 19, 2002

RICHARD D. LOVERING
PRIMARY EXAMINER
GROUP 1712